

Appn. No. 09/980,114
Supplemental Amendment filed September 23, 2005

Attorney Docket No. 82330

REMARKS/ARGUMENTS

Claims 1, 5, and 52 - 85 are presently in the case. Claims 52-55 have been allowed and as amended, Claim 1 (which is Claim 4 rewritten in independent form) and 5 should be allowable based on the first Office Action of December 2, 2004. Claims 56 - 85 are newly added.

This Supplemental Amendment incorporates all of the applicable remarks and arguments made in the Response and Amendment filed June 1, 2005 as though they were set forth herein. Attached to this Supplemental Amendment are currently unsigned, but reviewed and accepted declarations of Ronen Daniel, an inventor herein and the current Vice President of Sales and former Vice President of Marketing of Cellick Technologies Ltd, the assignee of this application (Cellick), and of Amit Gil, the current Chief Technical Officer and former Vice President of Research and Development of Cellick. Executed declarations are currently being obtained and will be submitted upon their receipt. This Remarks/ Arguments section of this Supplemental Amendment and the attached two declarations set forth the substance of the courteous Interview which the Examiner and his supervisor graciously granted the undersigned, Mr. Daniel, Mr. Gil, and Simon Kay, the IP Manager of Cellick, on August 23, 2005.

By this Amendment, those claims which were said to be allowed or allowable in the previous Office Action are set forth in independent form. In addition there is newly added a single independent claim, Claim 56, that is somewhat similar to Claim 15, and 29 claims dependent thereon. These claims were previously submitted to the Examiner in advance of the Interview, were discussed at the interview, and are now officially presented for consideration. Except for Claims 75 and 76 in which the word "checking" was added and Claims 80 and 83 in which "can be actuated" was substituted for "actuable," the present slate of claims is identical to those presented to the Examiner and discussed at the interview.

Newly added Claim 56 is directed to a cellular telecommunications method involving a personal cellular telecommunications device. Because Claim 56 is somewhat similar to now cancelled Claim 15, the rejections in the first Office Action of December 2, 2004 of Claim 15 will be expressly addressed.

Subsequent to the Interview, the Examiner brought to the attention of the undersigned the Martin et al. US Patent No. 6,363,419, which is now the subject of an IDS included herewith. This patent is very similar in its disclosure to the DE BOOR et al. patent discussed below. However, neither patent discloses any discarding of messages, as claimed in newly added Claim 56, and which feature is one of the key features of the present invention which, as set forth below, was responsible for the commercial success of the present invention.

The support for the newly added claims is found in the original claims and in the original specification, which is cited to by paragraphs in the published version for convenience. Specifically, the support is as follows:

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Independent Claim 56 by Claim 15 and ¶ 21; and

Dependent Claim 57 by Claim 9, Claim 58 by Claim 12, Claim 59 by Fig. 6 and ¶¶ 9 and 17, Claim 60 by Claim 22, Claim 61 by Claim 27, Claim 62 by Claim 17, Claim 63 by Claim 17, Claim 64 by Claim 16, Claim 65 by Claim 18, Claim 66 by Claim 8, Claim 67 by Claims 17 and 18, Claim 68 by Claims 16-18, Claim 69 by Claim 9, Claim 70 by Claim 10, Claim 71 by Claim 20, Claim 72 by Claim 18, Claim 73 by Claim 12, Claim 74 by Claims 13, 27 and 36, Claim 75 by Claims 15 and 25, Claim 76 by Claims 15 and 26, Claim 77 by Claim 1 and ¶¶ 16 and 21, Claim 78 by Claim 15, Claim 79 by Claim 1, Claims 80 and 83 by Claim 22, Claims 81 and 84 by ¶ 17 and Fig. 2, Claim 82 by Claim 1 and ¶ 5, and Claim 85 by Claim 7. In addition the entire specification and drawings provide support for the newly added claims.

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Rejection of Claim 15 under 35 USC §103

In the first Office Action, dated December 2, 2004, Claims 15, 16, and 18-26 were rejected as being obvious over the Lietsalmi et al. PCT publication (WO98/10604) in combination with the TAUBENHEIM ET AL.. US patent (6,060,997) and the DE BOOR ET AL. US patent (6,173,316).

The Examiner stated:

Regarding claims 15 and 24-26, LIETSALMI discloses a cellular telecommunications network including a plurality of individually addressable Base Transceiver Stations (BTSS) providing bi-directional signal coverage over a predefined geographical area, and capable of transmitting mostly different content, at least some interactive display messages where each interactive display message enable a subscriber to automatically activate a point-to-point transmission response mechanism integrally provided in a display message by a dedicated response means associated therewith, a method for operating a personal cellular telecommunications device having at least one dynamic storage buffer, and a subscriber interface including a display screen (page 2, line 9 to page 3 line 6, page 4 lines 27-32, page 5 line 25 to page 6 line 5, page 6 lines 21-26, page 7 lines 14-37, page 12 lines 19-25, page 13 line 10 to page 14 line 10 and page 15 line 6 to page 16 line 16). However, LIETSALMI et al does not explicitly disclose (a) temporarily storing display messages in a dynamic storage buffer ready for display on the display screen; (b) instead of displaying an idle screen on the display screen, automatically streaming display messages from the dynamic storage buffer on the display screen but interrupting their display to display a non-idle activity specific screen, if invoked, and (c) automatically discarding display messages from the dynamic storage buffer in accordance with a display message discard scheme irrespective of their having been displayed on the display screen or not. TAUBENHEIM et al discloses (a) temporarily storing display messages in a dynamic storage buffer ready for display on the display screen; (b) instead of displaying an idle screen on the display screen, manually setting a mode for streaming display messages from the dynamic storage buffer on the display screen and automatically discarding display messages from the dynamic storage buffer on the display screen, and (c) automatically discarding display messages from the dynamic storage buffer in accordance with a display message discard scheme irrespective of their having been displayed on the display screen or not (column 9 line 37 to column 12 line 21). TAUBENHEIM et al's display message discard scheme discard the message from memory after a time the message would have finished being displayed, regardless of it actually being displayed or not (see column 11 lines 33-51). As such TAUBENHEIM et al fails to teach automatically displaying the stream when in a idle mode and interrupting their display to display a non-idle

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activity specific screen, if invoked. DE BOOR et al. Which discloses displaying advertisements on a mobile device when in an idle state (column 13 lines 45-51 and column 36 line 55 to column 37 line 28). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of LIETSALMI et al., TAUBENHEIM et al and DE BOOR et al. TAUBENHEIM et al enhances the teaching of LIETSALMI et al by providing a way of handling the display of the received messages. It is particularly beneficial in that it allows for a reduced amount of memory, thus reducing the cost of the portable device. DE BOOR et al enhances the combination by replacing LIETSALMI et al's manual selection of streaming mode with an automatic selection. This is beneficial in that it makes the device easier to use for the user.

Although this rejection was applied to Claim 15, and Claim 56 is different, it is submitted that it is important to traverse the rejection should the Examiner desire to apply it to Claim 56.

Response

Legal Standards

Applicants respectfully traverse the rejections because all three prongs for a *prima facie* case of obviousness have not been established for each of the rejections. Specifically, all the claim limitations are not present in any one reference and one of ordinary skill in the art would have no motivation to combine and modify the cited references to arrive at the presently claimed invention.

The standard of patentability in obviousness rejections under 35 USC §103 is applied by first determining the scope and content of the prior art; then ascertaining the differences between the prior art and the claims considering the claimed invention as a whole; then resolving the level of ordinary skill in the pertinent art; and finally evaluating any evidence of secondary considerations. Graham v. John Deere Co., 383 US 1, 148 USPQ 459 (1966).

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. See Ex parte Clapp, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. Id. at 974. The teaching or suggestion to make the claimed combination and the reasonable expectation for success

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must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438. See MPEP §2143.

Applicants respectfully submit that the level of ordinary skill in the art is that of a telecommunications engineer with a college degree in telecommunications and practical experience of about two years. (See Gil Decl. ¶ 17), and submit that it would not have been obvious to such a person to combine the cited prior art as suggested by the Examiner to arrive at the presently claimed invention, and that the references themselves teach against such combination. Applicants also submit herewith two declarations which provide facts and evidence that proves that the invention is not obvious.

Background of the Invention

The present invention is in the field of cellular telecommunications networks and personal cellular telecommunications devices. This network is comprised of a number of operators, such as Cingular in the US, who are always looking for new ways to increase their revenue without making their users upset. The users will become upset if there is any intrusion into their cellular telephone world. If the operators make its cellular telephone users upset, they will lose subscribers. On the other hand, the cellular telephone includes a screen that usually only displays the "idle screen." The idle screen has been defined in the present application as the display screen that displays *inter alia* network related information, for example, the name of an operator, time, signal strength, battery strength, the presence of one or more voice messages and/or SMS messages stored in a permanent storage buffer prior to their deletion, and the like. Daniel et al. published application ¶ 6. This is real estate that can be utilized for other content so long as the user is not annoyed at this other use.

The Present Invention

The present invention relates to the use of the display screen of a personal cellular telephone to silently and unobtrusively display, display messages and in particular display interactive display messages. These are messages that include a means by which a user can respond to obtain more information. Upon activation of these interactive display messages, a message is sent to a further information provider, as determined by the message itself, and the user is charged a fee and thus is a source of revenue for a telecommunications operator.

The present invention recognizes, and is claimed in Claim 56, that the use of interactive display messages can be made unobtrusive and thus acceptable by the user if

the reception of the message is silent;
the message is received by the cellular phone and temporarily stored in the cellular phone;
the message is displayed only when an idle screen is being displayed;
the message is interrupted if a non-idle, activity specific screen needs to be displayed;
and

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the display messages are discarded silently and automatically irrespective of whether
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